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| 09/886,886 | 06/21/2001 | Ken Ilkka | 7104/94433 | 6121 |
| 24628 | 7590 | 01/28/2008 | EXAMINER | |
| WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606 | | | PARKER, FREDERICK JOHN | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/886,886

Applicant(s)

ILKKA, KEN

Examiner

Frederick J. Parker

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-10-07 has been entered in view of petition decision.

Specification

2. The disclosure is objected to because of the following informalities: (1) page 4, [0008]; page 6, [0016]; page 7, [017], the basis of the percentages (by wt, vol, molar, etc) are not stated. Appropriate correction is required.

3. Previous claim rejections/ objections are withdrawn in view of cancellation of all previous claims.

Claim Objections

4. Claims 29,30 are objected to because of the following informalities: the phrase " wherein the automobile part that is formed from a..." in context is awkward and requires re-wording. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 23-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification does not teach the limitation "the ink image being visible....vehicle" in the disclosure of the invention but rather is directed to the section on the Admitted Prior Art as stated by Applicants. While this supports obviousness, it does not support the limitation as being a valid part of possession of the invention at time of filing. Dependant claims are rejected because they intimately rely on the limitation deemed to be New Matter.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 23,24,28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 23 is vague and indefinite because in the "pressing" step, it is unclear if the ink image is visible only to a user, but none else, e.g. passengers, passersby, car thieves, etc; it is further unclear if the ink images must ONLY be visible when "mounted in the motor vehicle", but not prior to mounting; in the heating step, the intended meanings of "predetermined" are unclear and undefined in context.
- Claim 24 is vague and indefinite because the basis of the percentages are not cited; further the combination of 60% ink, 40% hardening agent, and an unstated % epoxy

make the composition exceed 100% which is impossible. Since the composition cannot be ascertained, for examination any composition will meet the limitation.

- Claim 28 is vague and indefinite because it is unclear how a "key-shaped icon" provides information "with respect to safe use of the motor vehicle".

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 23,25,29,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pryor et al US 4269874 in view of Alden US 4538560 alone or in combination with the Admitted Prior Art (APA) of [003].

11. The "Background..." section of Pryor et al teaches that in manufacturing, e.g. of automotive parts (encompassing any auto part materials without limitation), the parts are "routinely marked" with indicia without limitation to signify good versus bad parts, part type,

shift when made, etc which are visible to any sighted viewer. Marking has traditionally been carried out by means including stamp-type ink/ paint markers (inherently possessing raised ink printing portions which are the “image”) in which ink wets the stamp including raised portions of the image to be transferred onto the part (col. 1, 8-31). Applying the raised inked portions to a part plated with chrome is not taught. However, Alden teaches chrome plated engine valve covers, the chrome plating being applied to brighten the appearance of the engine and enhance worth of the automobile (col. 1, 13-17; col. 2, 46-48) and the part comprising metal and plastic (col. 1, 29-31). While marking the valve cover via ink stamping is not taught, Pryor et al teaches this to be routine for automobile parts, and hence it would have been obvious to the skilled artisan to have applied any such markings via ink stamping to signify quality, part type, or any other indicia, logo, etc for a specific automotive part. Further more, the specific logo, indicia, decoration, etc being stamped does not impart patentability because Pryor disclosed that automotive parts are successfully stamped with such images. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, In re Seid 73 USPQ 431. Applicants admit the limitation “the ink image being....motor vehicle” is known prior art and therefore obvious, see APA [003] as well as Remarks of 12/10/07, page 8, paragraphs 3-4.

The size of ink batches, stamp forming time, and exact composition would have been determined by routine experimentation for any end-use product, per claim 25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the ink stamping method of Pryor et al on the chrome plated part of Alden or

any other chrome plated part, because automotive parts are “routinely marked” with indicia, logos, and other designations by ink stamping.

12. Claims 26,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pryor et al US 4269874 in view of Alden US 4538560 and further in view of Reinke et al US 3170393.

Pryor and Alden are cited for the same reasons above. Heating the printed object is not cited. However, Reinke et al teaches the concept of printing inks onto substrates including metal, followed by drying at any suitable temperature between 200-325F (encompassing claim 26) using a suitable heating element to hasten the drying/ curing process of the ink. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Pryor et al in view of Alden by heating the printed metal article as taught by Reinke et al to hasten the drying/ curing process of the ink, and thereby improve the efficiency of the metal printing process. Specific heating times and temperatures, per claim 27, are result-effective variables conventional to a drying process that would have been determined by the skilled artisan by routine experimentation and/ or readily available technical information for any specific ink and printing process, and therefore would not patentably distinguish over the prior art.

13. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pryor et al US 4269874 in view of Alden US 4538560 and further in view of APA.

Pryor and Alden are cited for the same reasons above. Applying a “key-shaped icon” is not cited. However, Applicants admit the industry applies instructions, safety icons or indicia, and specifically keyhole icons, such that it would have been obvious to one of ordinary skill in the art

at the time the invention was made to carry out the method of Pryor et al in view of Alden by applying keyhole icons to appropriate portions of an automobile as it is known and conventional in the prior art.

Response to Arguments

Applicants argue use of an auto interior component which is chrome plated is not disclosed by the prior art. This is incorrect for three reasons 1) Alden cites Cr plated parts such as valve covers which are installed under the hood and therefore are in the interior of the car, 2) a careful reading of the independent claim as worded never requires the stamped surface to actually be in the car interior, and 3) Pryor teaches stamping ink markings onto auto parts, without limitation as to substrate type, is known in the art which includes Cr-plated articles. Applicant's arguments are thus non-persuasive,

Applicants' argue the indicia on chrome plated articles is visible to a motor vehicle user; this is unpersuasive because the meaning of the recited limitation is so unclear and confusing as to be essentially meaningless. It is unclear how a bystander, car user, auto mechanic, car thief, toll taker or anyone else would apparently *be unable* to read the stamped indicia. The limitation is thus simply directed to intended use as admitted on arguments of page 9, Response, and therefore receives little or no patentable weight.

Regarding Applicants' allegations of the Examiner "cherry picking" the prior art, the fact is that Pryor (as well as the APA) teaches it is customary in the auto industry to use marking units such as stamps to apply ink codes, indicia, and other markings without limitation of material being stamped. Alden expressly teaches Cr-plated parts for auto interior parts so there would be no leap of applying stamped images to chrome plated parts. Applicants admit in [003] that

indicia are "imprinted on automobile parts" and in [004] that printing on Cr-plated parts is know, regardless of the drawbacks. Applicants' claim language simply requires what is known in the prior art without addressing the alleged "drawbacks" which might imply patentability, so that the claims as presented are obvious in view of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Frederick J. Parker
Primary Examiner

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